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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,889	09/25/2003	W. Preston Barnes	3227R	2450

26645 7590 05/22/2007
THE LUBRIZOL CORPORATION
ATTN: DOCKET CLERK, PATENT DEPT.
29400 LAKELAND BLVD.
WICKLIFFE, OH 44092

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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05/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,889	BARNES ET AL.	
	Examiner	Art Unit	
	Vickey Ronesi	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/10/2007 has been entered.
2. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. Claims 1-8, 11-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al (US 6,642,191) in view of L'Heureux (US 6,455,477) or Chamberlin (US 5,422,022).

The rejection is adequately set forth in paragraph 4 of Office action mailed 2/22/2006 and is incorporated here by reference.

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5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al (US 6,642,191) in view of L'Heureux (US 6,455,477) or Chamberlin (US 5,422,022) and further in view of Tipton et al (US 5,354,485).

The rejection is adequately set forth in paragraph 5 of Office action mailed 2/22/2006 and is incorporated here by reference.

Response to Arguments

6. Applicant's arguments filed 4/10/2007 have been fully considered but they are not persuasive. Specifically, applicant argues that Palazzotto et al fails to teach that differences in lubricant composition performance are shown when using detergent with various Total Base Number (TBN) values as shown by the Declaration dated 4/5/2007.

In response to applicant's argument, while Palazzotto et al does not teach a preferred Total Base Number of the detergent, Palazzotto et al was not solely relied upon to teach in the Total Base Number. In particular, L'Heureux teaches the known use of metal sulfonate detergent with a relatively low TBN in two-cycle engines and Chamberlin teaches the superior rust and corrosion inhibition properties had by using a detergent with a TBN less than 110 in a lubricant composition. Furthermore, Palazzotto et al teaches that two-cycle engines often require ashless lubricant composition to minimize the extent of harmful deposits (col. 11, lines 60-66). Therefore, it would have been well within the capabilities of one of ordinary skill in the art to utilize a detergent with a TBN of less than 100 in a lubricant composition for use in a two-cycle engine.

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The data in the Declaration dated 4/5/2007 has been fully considered, however, it is insufficient to establish unexpected or surprising results for the present invention because the data is not reasonably commensurate in scope with the claimed invention. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). In particular, the detergent of the inventive examples only has a TBN of 32, which is insufficient to establish criticality for the presently claimed range of up to about 30 given that it is not clear how or if about 30 encompasses 32. Furthermore, only one inventive data point is given for a TBN of up to about 30 and case law holds that whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Also, the data is not a proper comparison to the closest prior art given that the prior art of L'Heureux and Chamberlin teach TBN numbers of less than 200 and the comparative examples have TBN values of 418 and 517, i.e., a comparison of a TBN of 32 to a TBN of 418 or 517 cannot establish criticality over less than 200 as already taught by prior art. Case law holds that comparative showings must compare the claimed subject matter with the closest prior art to be effective. See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979).

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/17/2007
Vickey Ronesi



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